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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/433,135	11/03/1999	JOHN G. SAVAGE	8243.00	2108

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/433,135

Applicant(s)

SAVAGE ET AL.

Examiner

Ruhl Dennis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 36-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 36-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's response of 5/13/03 has been entered. Currently claims 1-21,36-42 are pending. This office action is non-final because of the new grounds of rejection being applied to the pending claims.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. For claim 37, there is no antecedent basis for "the microphone". It is not clear what microphone is being referred to because no microphone has previously been recited. It is also not clear how a microphone can be directional to minimize overhearing by third parties. A microphone takes in sound (is not a speaker) so how can a third party hear anything at all from a microphone? Correction is required.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3,5-9,11-13,15-21,36,37,40, are rejected under 35 U.S.C. 102(e) as being anticipated by Rabin (6081782).

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For claims 1,6,11,17,36,40, Rabin discloses a self service terminal, such as an ATM, and its associated method of use. Rabin discloses that voice recognition can be employed to allow easier confirmation of a user's identity. Rabin discloses instructing means for producing audible instructions/generating unit (203), dispensing means for dispensing funds (see column 3, line 15), interface means that allows manual interaction (106), speech recognizing means (117), and means for processing spoken instructions (111).

For claims 2,7,12,18, the breadth of the claimed limitation is satisfied by Rabin. The examiner considers Rabin to disclose "natural speech" as this is a very broad limitation.

For claims 3,8,13,19, because the ATM can recognize a user's voice for identification purposes, it will inherently be able to recognize the accent of a user. When the user initially speaks so that their voice is saved in the processor for later analysis, the initial voice will have the speaker's accent; therefore, when the speaker uses the ATM in the future, the ATM will be able to recognize the user's accent (voice).

For claims 5,15, the ATM disclosed by Rabin does verify the ID of the user, this is what Rabin is primarily concerned with.

For claims 9,20, the instructions produced by the ATM are tailored to provoke a number of predetermined responses (balance inquiries, accounts transfers, withdrawal of funds, etc.).

For claim 16, the card reader is disclosed in column 3, lines 12-13.

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For claim 37, the examiner considers it inherent that the ATM of Rabin will have a microphone; otherwise there would be no way to process the spoken instructions of the user. With respect to the limitation of "directional", all microphones are directional to some extent.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4,10,14,21,38,42, are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabin (6081782). Rabin does not disclose that the ATM can produce instructions in a plurality of predetermined voices. The examiner has consulted the instant specification and notes that having the ATM give instructions in a plurality of voices does not solve any stated problem or produce any unexpected result; therefore, having the ATM give instructions in a plurality of voices is considered to be a matter of

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design choice. The examiner also notes that the device will not operated any differently if a plurality of voices is used as opposed to giving instructions in one voice only. The limitations of claims 4,10,14,21,38,42, are not sufficient to patentably distinguish over Rabin.

7. Claims 39,41, are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabin (6081782) and further in view of Paganini et al. (4420751). Rabin does not disclose a location determining means for determining the location of the customer. Paganini discloses an ATM that has a location determining means for determining the location of the customer for numerous reasons as discussed in column 1, line 50 to column 2, line 20. Paganini discloses that the location determining means can prevent the problems discussed in column 1, line 50 to column 2, line 20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Rabin with a location determining means as disclosed by Paganini so that the problems with ATM machines discussed by Paganini in column 1, line 50 to column 2, line 20 can be avoided.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

At least claims 1,5,17,36, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6484936. Although the conflicting claims are not identical, they are not patentably distinct from each other because for claims 1,5, the claimed difference of having a dispensing means to dispense funds (or whatever item is being sold by the self service terminal) would have been obvious to one of ordinary skill in the art at the time the invention was made, so that you can get money or whatever it is you order. It is also considered obvious to one of ordinary skill in the art at the time the invention was made to provide the self service terminal with an interface to allow manual interaction so that a person who chooses not to interact verbally (for privacy because others are in the vicinity, or someone may have lost their voice due to illness) can still interact with the self service terminal manually. For claims 17,36, applicant is simply broadening out the claims and failure to claim an element is considered obvious to one of ordinary skill in the art. This is an *In re Goodman* type of double patenting rejection. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

Claim 22 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6241151. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only claimed difference of having a processor to control the

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ATM is considered obvious to one of ordinary skill in the art. Clearly a processor is required to control the ATM; otherwise it would not be able to properly function.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703 308 2262.

The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703 308 2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER